

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of

SUNDGREN

Atty. Ref.: 4448-44; Confirmation No. 1250

Appl. No. 10/583,117

TC/A.U. 3617

Filed: August 22, 2006

Examiner: Robert J. McCarry, Jr.

For: GUIDE RAIL OF COMPOUND TYPE AND A METHOD FOR MANUFACTURING
SUCH A RAIL

* * * * *

August 26, 2009

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

PRELIMINARY COMMENTS ACCOMPANYING
REQUEST FOR CONTINUED EXAMINATION

Submitted herewith is a Request for Continued Examination which is being filed along with an Information Disclosure Statement. In addition, petition is hereby made for a three month extension of time.

In the Information Disclosure Statement, Applicant cites a copy of a Communication issued in relation to a corresponding European application on February 17, 2009, along with the art cited therein. It is noted that document D3 (DE 196 13 719C1) was previously cited in the Information Disclosure Statement filed on June 16, 2006, and was already considered by the Examiner. Further, document D4 (U.S. Patent No. 5,645,653) was already cited and considered by the Examiner on the June 16, 2006 Information Disclosure Statement.

Applicant respectfully points out that in the corresponding European application, now allowed, claims similar to those presented in the present U.S. application were presented and initially rejected over document D1 (GB 2 231 544). In the European Office Action, the Examiner took the position that the outer rail 11 has a yield point exceeding that of the base rail 10 of document D1. According to the European Examiner, D1 discloses a guide rail comprised of an aluminum body to which is attached a facing layer formed from two stainless steel strips welded together. However, like Pelletier, document D1 has no teaching or disclosure as to whether the aluminum body or the two stainless steel strips has a higher yield point. In particular, like the U.S. Examiner, the European Examiner took the position that the skilled person in the field of composite rails is aware of the fact that aluminum shows a much lower yield point than steel. In response to the European Office Action, the Applicant argued that D1 does not disclose a compound guide rail wherein the outer rail has a yield point exceeding that of the base rail. Specifically, as indicated on page 3 of 7 of the April 27, 2009 Response “... there is no per se rule that a stainless steel as such has a higher yield point than aluminum...”. In the European Response, reference is made to a publication from the Swedish Trade Association of the Swedish Steel Industry Jernkontorets Forskning D812 with the title “Steel and Aluminum – A comparison of material properties, LCI and recycling”. This document is cited on the attached Information Disclosure Statement.

As Pelletier does not specify the tensile properties, manufacturing process, purity and composition of its stainless steel and aluminum, there is no way to determine whether the outer rail would have a yield point exceeding that of the base rail. Reference is made to the April 27, 2009 response to the European Office Action, especially page 3 of 7, second and third full paragraphs in which specific examples of the Swedish Trade Association’s material comparison

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results are shown in which stainless steel and aluminum can very easily have yield strengths which are opposite to what is claimed.

The European application is being allowed.

Reconsideration and withdrawal of the rejections are respectfully requested.

In view of the above amendments and remarks, Applicant respectfully submits that all the claims are patentable and that the entire application is in condition for allowance.

The Commissioner is hereby authorized to charge any deficiency, or credit any overpayment, in the fee(s) filed, or asserted to be filed, or which should have been filed herewith (or with any paper hereafter filed in this application by this firm) to our Account No. 14-1140 under Order No. PTB-4448-44.

Should the Examiner believe that anything further is desirable to place the application in better condition for allowance, he is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,

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